

P25065.A04



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Wiebke LINDEMANN et al.

Confirmation No.: 6812
Group Art Unit: 1616

Serial No. : 10/809,415

Examiner: unknown

Filed : March 26, 2004

For : DECORATIVE SKIN CARE PRODUCT

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Amendment
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Pursuant to 37 C.F.R. § 1.56 and 37 C.F.R. §§ 1.97-1.98 and supplemental to the Information Disclosure Statement filed October 6, 2004, Applicants hereby direct the Examiner's attention to an Examination Report which issued in connection with German Patent Application 101 48 264.7 of which the above-referenced application claims priority. The passage of the Examination Report which deals with patentability states the following (unverified translation):

In this Office Action, the following references are mentioned for the first time (the numbering thereof also applying to the further proceedings:

- (1) DE 199 34 946 A1
- (2) DE 199 34 943 A1
- (3) DE 198 43 876 A1
- (4) DE 198 05 827 A1

- (5) DE 198 02 205 A1
- (6) DE 197 38 641 C1

Claims 1 to 9 as originally filed are pending.

Emulsions which contain fatty acids, fatty alcohols, stearates, humectants, in particular glycerin and silicone oils, and to which can also be added pigments or as oil component dicaprylyl ether are known from (1), in particular claims 1 through 6, 8, 9; table 1; page 8, lines 17 through 27; page 9, line 3; page 10, lines 9, 40 through 45 and (2), in particular claims 1 through 6, 8, 10; page 8, line 46; page 10, lines 13 through 18.

In (3), cosmetic formulations are described which, with the exception of the constituent fatty alcohol of the current main claim 1, contain all other components. The missing component, however, can easily be supplemented by one skilled in the art who works in the field of producing cosmetics, since this component is a common cosmetic ingredient, see also the respective general specification sections in (1) through (5) of the components coming into consideration.

The same applies to documents (4) through (6), as in these all constituents a) through f) of claim 1 are recited in the specifications and only one or two of components a) through f) each are missing in the examples, but can be supplemented easily.

Furthermore, the claimed surprising effect of the reduction of the stickiness of cosmetic preparations containing glycerin cannot establish patentability either, as this effect is already known from (1), page 3, lines 35 through 38 and (2), page 3, lines 36 through 39.

In addition, example 4 of the application documents does not contain dicaprylyl ether, which is stated as a required element of claim 1. Consequently, components a) through c), d) and f) obviously suffice to achieve the effect, which, however, has already been described in (1) and (2). The same applies to example 11 in (3) and example 6 in (4). Furthermore, the addition of a further substance (here dicaprylyl ether) to the formulation, through which substance an improved effect of the formulation was not to be expected, if an improved effect does not occur through this addition as expected, can establish the existence of an inventive activity (cf. BGH (Federal Court of Justice) "Trigonellin" GRUR (Industrial Property Protection and Copyright) 2001, pages 730 through 732).

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Under these circumstances, the applicant cannot anticipate being successful by further pursuing this application. Rather, a rejection of the application for the above-stated reasons must be expected.

Applicants note that copies of documents (1) to (6) cited in the German Examination Report have already been submitted in the Information Disclosure Statement filed October 6, 2004 (see documents (7)-(9) and (11)-(13) cited therein).

A copy of the Examination Report for German Patent Application 101 48 264.7 is enclosed herewith. Accordingly, the Examiner is respectfully requested to consider the information submitted herein.

Applicants note that an Office Action on the merits has not yet issued in the instant application, and thus, no fee is necessary to ensure consideration of this statement. However, if an Office Action has issued and is crossing in the mail with this statement, the Patent and Trademark Office is hereby authorized to charge Deposit Account No. 19-0089 any fee necessary to ensure consideration of the submitted information.

If there should be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Wiebke LINDEMANN et al.

Heribert F. Muenster

Neil F. Greenblum

Reg. No. 28,394

Heribert F. Muenster

Reg. No. 50,417

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191